

**REMARKS**

This Amendment is filed in response to the Office Action mailed on June 13, 2006. All objections and rejections are respectfully traversed.

Claims 1-28 are in the case.

Claims 24-28 were added to better claim the invention.

Claims 1 and 22-23 were amended to better claim the invention.

**Rejections Under 35 U.S.C. § 101**

At paragraph 1 of the Office Action, claims 18-20 were rejected under 35 U.S.C. § 101 as being non-statutory subject matter.

Applicant's claim 18, representative in part of the present invention states:

18. A system for verifying a configuration of a storage environment having at least one storage system and a client, the system comprising:  
a *configuration verification program executing on the client* and including means for determining versions of components of the storage environment;  
means for determining configuration settings of components of the storage environment;  
means for determining if one or more components of the storage environment have failed; and  
means for presenting a report to a user identifying a set of warnings and errors with the configuration of the storage environment.

Applicant respectfully points out that MPEP 2107 IV, B. (Page 2100-40 to 2100-41 of the Eighth Edition) states:

To properly reject a claimed invention under 35 U.S.C. § 101, the Office must (A) make a *prima facie* showing that the claimed invention lacks utility, and (B) provide sufficient evidentiary basis for factual assumptions relied upon in establishing the *prima facie* showing. *In re Gaubert*, 524 F.2d 1222, 1224, 187 USPQ 664, 666 (CCPA 1975) (“Accordingly, the PTO must do more than merely question operability – it must set forth factual reasons which would lead one skilled in the art to question the objective truth of the statement of operability.”). If the Office cannot develop a proper *prima facie* case and provide evidentiary support for a rejection under 35 U.S.C. § 101, a rejection on this ground should not be imposed.

Applicant respectfully points out that the form of Claim 18 meets the “practical application” requirement of MPEP 2107 IV, B. because the claim is to be: “***a storage environment having at least one storage server and a client, the system comprising: a configuration verification program to execute on the client***”, and then the system is spelled out in the system claims.

Accordingly, Applicant respectfully urges that Claim 18 meets all statutory requirements of 35 U.S.C. 101, particularly as further set out in MPEP 2107 IV, B. Further, Applicant respectfully urges that Examiner has not made a *prima facie* showing that the claimed invention lacks utility and urges Examiner to provide sufficient evidentiary basis for factual assumptions relied upon in establishing the *prima facie* showing.

### **Rejections Under 35 U.S.C. § 112**

At paragraph 2 of the Office Action, the Examiner rejected claims 22 and 23 under 35 U.S.C. § 112, paragraph 2 for insufficient antecedent basis for the limitation, “the storage system.” Applicant thanks the Examiner for pointing out the typographical errors in claims 22 and 23 which have been corrected by way of this Amendment.

**Rejections Under 35 U.S.C. § 102**

At paragraph 5 of the Office Action, claims 1-6 and 9-21 were rejected under 35 U.S.C. §102(e) as being anticipated by Brisse U.S. Publication No. 2003/0055932 published on March 20, 2003 hereinafter (“Brisse”).

Applicant’s claim 1, representative in part of the present invention states:

1. A method for verifying a configuration of a storage environment having at least one storage system operatively interconnected with at least one client, the method comprising the steps of:

*initiating a configuration verification program on at least one client* to determine:

- (i) versions of components of the storage environment;
  - (ii) configuration settings of components of the storage environment; and
  - (iii) if one or more components of the storage environment have failed; and
- presenting a report to a user identifying a set of warnings and errors with the configuration of the storage environment.

Brisse discloses a method for “configuring a storage area network (SAN)...the system [including]...multiple SAN elements that a user may select as well as a design module in which the selected SAN elements may be graphically configured” (Abstract). The user interface (UI) for Brisse’s method is a “configuration tool user interface [including] selectable SAN devices which may be graphically selected in [a] design module using a drag-and-drop type technique” (Brisse ¶ 30). Brisse’s publication “provides [a] designer of a SAN with...information regarding the necessary SAN elements required to install and deploy a *contemplated* SAN configuration” (emphasis added; Brisse ¶ 36). In other words, Brisse discloses a way to *design* a SAN and configure it using computer aided design (CAD) software *before* it is physically set up and put into practice.

Applicant respectfully urges that Brisse does not show Applicant's novel *configuration verification program on at least one client*.

Applicant's claimed invention uses a *configuration verification program* (CVP) executed *on at least one client* of a physical storage environment. "Once activated, the CVP communicates with the appropriate storage appliances, switches, clients and/or other components within the storage environment to perform a thorough check of the storage environment's configuration" (Applicant's Specification; page 15, lines 16-19). A client "may be a general-purpose [computer] configured to execute applications over a variety of operating systems" (Applicant's Specification; page 9, lines 14-26). In other words, Applicant's claimed invention is implemented on a SAN which is already *physically* operable. This is evidenced by one of the CVP's functions of checking physical cable connectivity. The "CVP checks that cables are properly connected so that components are interconnected" (Applicant's Specification; page 16, lines 14-16). Another function of the CVP is to "ensure that the various components of the storage environment have not failed with particular emphasis on redundant data pathways that may not be obvious in their failure" (Applicant's Specification; page 16, lines 17-20).

As such, Brisse's patent application discloses a method for designing a future SAN using CAD, and then verifying the designer's contemplated SAN configuration within the CAD program itself. This is distinct from Applicant's claimed invention, which implements a *configuration verification program on at least one physical client* to ensure there are no, *inter alia*, "improper versions, [physical] misconfigurations, [and any] failed [physical] components" in the physical storage environment configuration (Applicant's Specification; page 16, lines 23-26).

Applicant respectfully urges that the Brisse publication is legally precluded from anticipating the claimed invention under 35 U.S.C. § 102 because of the absence from

the Brisse publication of Applicant's novel use of a *configuration verification program on at least one client*.

Similarly, independent claims 15, 18 and 21 and dependent claims 2-6, 9-14, 16-17, and 19-20 also include limitations of Applicant's novel use of a *configuration verification program on at least one client*. As noted above, Blisse does not teach or disclose the concept of using a *configuration verification program on at least one client*. As such, Blisse does not anticipate these claims.

#### **Rejections Under 35 U.S.C. § 103**

At paragraph 25 of the Office Action, claims 7, 8, 22 and 23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Brisse in view of Heitman et al., U.S. Patent No. 6,920,494 issued on July 19, 2005, hereinafter ("Heitman").

As noted above, Brisse does not disclose or teach Applicant's claimed novel use of a *configuration verification program on at least one client*. As such, Applicant respectfully urges that Brisse, taken singly or in combination with Heitman, is legally insufficient to render the presently claimed invention obvious under 35 U.S.C. § 103. Brisse and Heitman, taken singly or in combination, do not teach Applicant's claimed novel use of a *configuration verification program on at least one client*.

Furthermore, claims 7, 8, 22 and 23 are dependent claims from allowable independent claims that include limitations of a *configuration verification program on at least one client* as used in Applicant's claimed invention. As noted above, Applicant respectfully urges that Brisse, taken singly or in combination with Heitman, is legally insufficient to render the presently claimed invention obvious under 35 U.S.C. § 103.

Brisse and Heitman, taken singly or in combination, do not teach Applicant's claimed novel use of a *configuration verification program on at least one client*.

All independent claims are believed to be in condition for allowance.

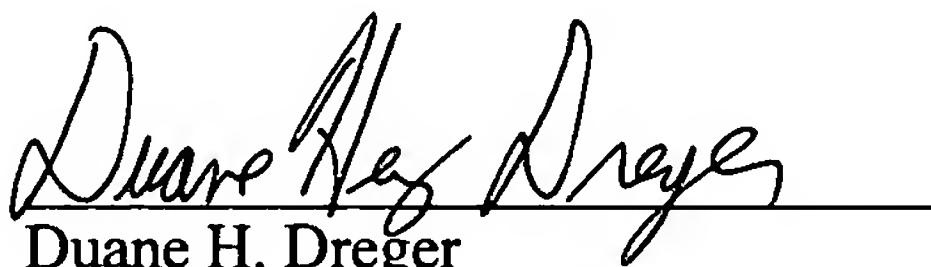
All dependent claims are believed to be dependent from allowable independent claims, and therefore in condition for allowance.

Favorable action is respectfully solicited.

Should the Examiner feel personal contact is required to discuss this matter further, please do not hesitate to call the undersigned attorney at (617) 951-2500.

Please charge any additional fee occasioned by this paper to our Deposit Account No. 03-1237.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Duane H. Dreger", is written over a horizontal line.

Duane H. Dreger

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